



S&H Form: (2/01)

Docket No.: 1330.1058 (PIK)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Steven C. MUTSCHLER, et al.

Serial No. 09/729,090

Group Art Unit:

Confirmation No. 3278

Filed: December 5, 2000

Examiner: Unassigned

For: ELECTRONIC NEGOTIATION AND FULFILLMENT FOR PACKAGE OF FINANCIAL PRODUCTS AND/OR SERVICES

PETITION UNDER 37 CFR 1.47

INVENTOR REFUSES TO EXECUTE APPLICATION

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The above-referenced application was filed on behalf of two inventors, namely, Steven C. Mutschler, and Sandra L. Devine. Mr. Mutschler resides as 1702 Burkwood Court, Vienna, VA 22180. Ms. Devine resides at 3856 N. Rixley Street, Arlington, VA 22207.

Mr. Mutschler executed a Declaration/Power of Attorney, and also an Assignment to American Management Systems, Inc. (AMS). The Declaration/Power of Attorney and the Assignment were filed concurrently herewith.

However, Ms. Devine refuses to execute a Declaration/Power of Attorney or an Assignment.

Ms. Devine was employed by AMS during the conception and development of the invention. Her rights in the invention are subject to an assignment to AMS due to her employment by AMS. However, Ms. Devine has since left AMS and is now employed by Sapient Corporation, One Memorial Drive, Cambridge, MA 02142. Since Ms. Devine has left AMS, she believes it would not be appropriate for her to sign documents related to her activities while employed at AMS. AMS has made diligent efforts to have Ms. Devine execute a Declaration/Power of Attorney and an Assignment, but Ms. Devine still refuses to do so.

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As proof of the relevant facts, enclosed herewith is a letter from Mary McCullough of AMS to Ms. Devine, dated February 27, 2001, forwarding the application, Declaration/Power of Attorney and Assignment for execution.

Also enclosed is a letter from Ms. Devine to Mary McCullough of AMS, dated April 30, 2001, in which Ms. Devine writes "Under the terms of the AMS intellectual property agreement, AMS holds rights to any intellectual property I may have developed while AMS employed me. As I am now employed at another firm, it is not appropriate for me to have further dealing on this matter."

Also enclosed is an email from Ms. Devine from Jim Stockmal of AMS, in which Ms. Devine writes "Sapient [Ms. Devine's current employer] legal team here is not in favor of me signing any documents relating to intellectual property for another company, and I am bound by my agreements here. So – I am not in a position to sign and unfortunately, I guess that means AMS needs to follow alternative paths on this."

From the above, it should be understood that Ms. Devine is under a legal obligation to assign her rights in the invention to AMS, but, since she no longer works at AMS, has refused to do so. Accordingly, this Petition is filed to preserve the rights of AMS.

In view of the above, AMS hereby makes application for patent on behalf of and as agent for Ms. Devine. Accordingly, it is requested that the Declaration/Power of Attorney of the remaining inventor, Mr. Mutschler, be made of record, and that the subject application be examined on its merits.

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The fee for filing this Petition in the amount of \$130.00, as required by 37 CFR § 1.17(i) is enclosed herewith. If there are any additional fees associated with filing of this Petition, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date:

May 7, 2001

By:

Paul I. Kravetz

Paul I. Kravetz
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700 Eleventh Street, NW, Suite 500
Washington, D.C. 20001
(202) 434-1500



American Management Systems, Inc.

February 27, 2001

Sandy Devine
3856 N. Rixey Street
Arlington, VA 22207

Dear Sandy:

AMS filed the Electra patent application in December 2000. We now need your signature on two forms required by the US Patent and Trademark Office for the patent application. Enclosed are copies of the two forms and a copy of the final draft of the patent application. Please note that this is AMS Confidential information.

Please review the information, sign the forms, and return them along with the draft application to our patent attorneys in the enclosed FedEx envelope. Feel free to call me at 703-267-2132 if you have any questions.

Sincerely,

A handwritten signature in cursive script, reading 'Mary McCullough', is written above the printed name.

Mary McCullough

April 30, 2001

Mary McCullough
One Chase Plaza – 36th Floor
New York, NY 10005

Dear Mary:

I received the packet relative to the Electra patent. I am returning this packet unread.

Under the terms of the AMS intellectual property agreement, AMS holds rights to any intellectual property I may have developed while AMS employed me. As I am now employed at another firm, it is not appropriate for me to have further dealings on this matter.

Please accept my apologies, but I believe you do not need my involvement to pursue patenting rights for Electra at this time.

Sincerely,



Sandy Devine



Sandy Devine
<sdevine@sapient.co
m>

To: Jim Stockmal/AMS/AMSINC@AMSINC
cc:
Subject: RE: f/u plus Electra

05/03/01 03:24 PM

Jim -- I really do not mean to be obstructionist at all on Electra. However, my Sapient legal team here is not in favor of me signing any documents relating to intellectual property for another company, and I am bound by my agreements here. So -- I am not in a position to sign and unfortunately, I guess that means AMS needs to follow alternative paths on this.

Would look foward to catching up for golf and whatever. Have been traveling heavily so weekends have been maxed to the gills with errands and kids stuff. Will get in touch when the runway clears and hope your family is well.

Best,
Sandy



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